

Application Serial No.: 09/357,957
Amendment dated March 8, 2005
Response to January 14, 2005 Office Action

REMARKS

Applicant's attorney acknowledges the interview at the United States Patent and Trademark Office on February 25, 2005 and the courtesy extended by the examiner ~~at that time~~. Applicant's attorney presented amendments to the claims using the same format as ~~the~~ claims in copending application Serial No. 09/359,809, also acted on by examiner Toomer.

The amendments describe the lubricants of the invention as a material for lubricating a surface which the last paragraph on page 30 of the written description supports. The amendments include a material for lubricating a surface optionally with an organic lubricant, or water, or lubricant additive. The written description supports the organic lubricants at pages 6-14 and the paragraph bridging pages 25-26, whereas pages 15-18 support inorganic lubricants, and water at page 25, first full paragraph, lubricant additives in the claims as originally filed, and mixtures at page 26, second full paragraph inter alia.

The written description supports the amendments to claim 29 comprising a material for lubricating a surface that includes (1) a lubricating metal and alloys thereof, lubricating metal oxide, halide, nitride, carbonate and phosphate, or carbon lubricants; or (2) a silicate ester, polyphenyl ether, phosphate, chlorinated biphenyl, phenanthrene or phthalocyanine. The examiner was in agreement that similar amendments in copending application Serial No. 09/359,809 found support in the claims previously in that case, however, applicant in the present application relies on the claims and the written description to support the terminology now used.

For example claim 38 of the present application supports the terms a "lubricating metal and alloys thereof, lubricating metal oxide, halide, nitride, carbonate and phosphate, or carbon

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lubricants" whereas the written description supports the term "silicate ester" at page 10, line 3 and page 12, penultimate paragraph; "polyphenyl ether" at page 10, line 3; "phosphate" at page 8, line 1, and the paragraph bridging pages 11 and 12; "chlorinated biphenyl" at page 12, line 2; "phenanthrene" at page 17, paragraph 1; and "phthalocyanine" at page 17, paragraph 1, and page 13, paragraph 2, last line.

The amendment to claim 30 describes a material for lubricating a surface comprising a solid or particulate inorganic lubricant optionally with an organic lubricant, or water, or lubricant additive. The amendment to claim 29 also includes optional organic and inorganic lubricants. The written description supports the organic lubricants at pages 6-14 and the paragraph bridging pages 25-26, water at page 24, first full paragraph, lubricant additives in the claims as originally filed, and mixtures at page 23, penultimate paragraph, and previously presented claim 29 inter alia. The amendments to claims 32 and 38 delete the second occurrence of "indium."

THE REJECTION UNDER 35 U.S.C. §112 SECOND PARAGRAPH AND TRAVERSE

The examiner rejects claims 32 and 43 under 35 U. S. C. § 112, second paragraph. Applicant traverses the rejection and requests further consideration and reexamination.

The examiner rejects claim 32 for the reason that claim 31 does not set out antecedent basis for the recited compounds. Applicant has amended claim 32, to make it multiply dependent on claim 29 or 30, each of which recite a "material for lubricating a surface" which comprises terminology broad enough to include the materials of claim 32. The amendment to claim 32 makes the rejection moot since claim 32 no longer depends on claim 31. The

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amendment to claim 43 deletes "and" to address the rejection that the claim did not recite additional materials.

THE REJECTION UNDER 35 U.S.C. §103 (a) AND TRAVERSE

The examiner rejects claims 35, 36, 52, and 53 under 35 U.S.C. § 103 (a) as unpatentable over Johnson U.S. Patent No. 5,275,760 in view of Garner et al. JCE 1997 (74) 95 [Jan], ("Garner"). Applicant traverses the rejection and requests further consideration and reexamination.

Johnson does not teach an inorganic lubricant, whereas the amendments to the claims require a composition with an inorganic lubricant. Garner does not constitute prior art since it bears an effective date more than one year after applicant's earliest priority application.

The examiner rejects claims 29, 31, 32, 35, 37, 38 and 52 under 35 U.S.C. § 103 (a) as unpatentable over Martineau et al. United States Patent No. 4,997,192 ("Martineau"). Applicant traverses the rejection and requests further consideration and reexamination.

Applicant's amendment to claim 29 excludes silicates from the claim 29 composition which distinguishes the Martineau teaching of mica (a magnesium silicate) in combination with a superabsorbent polymer that the examiner relies on to reject the claim. Claims 31, 32, 37 and 38, dependent on claim 29 also do not include mica to the extent they incorporate the claim 29 limitation. These claims also depend from claim 30 which the examiner indicated she would allow if written in independent form. The present amendment addresses this objection, so the claim 29 dependency of claim 30 does not bring the Martineau rejection into this aspect of the

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claims, and applicant's distinction of Martineau as noted previously does not apply to the claim
30 invention of claims 31, 32, 37, and 38.

The examiner also rejects claim 52 over Martineau, however, the amendment canceling
claim 52 without prejudice or disclaimer makes this rejection moot.

ALLOWABLE SUBJECT MATTER

On page four of the Office Action, the examiner objects to claims 30, 41, 42, ~~45-50~~, 56,
58, 60, 62, 64, 66, 67, and 68 but indicates she would allow them if written in independent form.
The amendment addresses the rejection by amending the independent claims as suggested by
the examiner, or by amending the independent claims to avoid the references cited in the
rejection of these claims. Applicant therefore requests allowance of these claims.

In view of the indication of allowability of claim 30, applicant adds claim 83, a process
claim modeled after composition claim 30, and product by process claim 84 dependent on claim
83 and requests allowance of these claims as well.

Page five of the Office Action also indicates the examiner has allowed claims 34, 41, 55,
57, 59, 61, 63, 65, 69, 70, and 71.

CONCLUSIONS

Applicant requests the Examiner to withdraw the rejections in view of the

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foregoing amendments and remarks and pass the application to issue.

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

March 8, 2005

By: /Robert J. Eichelburg, Reg. No. 23,057/

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March 8, 2005

By: /Robert J. Eichelburg, Reg. No. 23,057/

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